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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,079	03/23/2004	Abaneshwar Prasad	100216	2542

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EXAMINER

ACKUN, JACOB K

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/807,079

Applicant(s)

PRASAD, ABANESHWAR

Examiner

Jacob K. Ackun Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 20-23 and 47-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 24-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/26/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-19 and 24-46 are finally rejected under 35 U.S.C. 103(a) as obvious over Prasad et al, Hirokawa et al, Truong or Lombardo et al. Each reference teaches a polishing pad comprising hydrophilic and hydrophobic material. Based on the disclosure in each reference the elements recited in all of the claims would have been obvious, if not disclosed, for the purpose of facilitating the provision of a better performing pad. According to applicant, what each reference may not teach is that the material of the polishing pad is a copolymer having a hydrophilic and hydrophobic repeat unit. However as noted previously and above construction of the pads of the references from this material would have been obvious for the reasons stated.
3. Claims 1-19 and 24-46 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hiwatashi et al. Hiwatashi discloses most of the elements of the claims including a cosmetic comprising the hydrophilic and hydrophobic materials recited in the claims (note claim 1). On the other hand Hiwatashi lacks a teaching of a polishing pad substrate. However, it is noted that it is conventional to use some sort of pad to apply cosmetic to the skin or other part of the body. Accordingly, it would have been obvious to provide the claimed materials on some sort of pad in order to provide a convenient means of application of the materials to the body. Claims such as claim 1 read on the resulting article because the phrase "polishing pad substrate" as used by itself, without more, does not limit the claims to polishing pads of the type disclosed in the instant specification.
4. Applicant's arguments filed on 11/02/2005 have been fully considered but they are not persuasive. The applicant argues that there is no suggestion or motivation in the prior art to

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modify the prior art pads as noted in the rejection. The examiner again finds otherwise. It is believed to be quite clear from the references applied in the first ground of rejection that it was desirable and/or advantageous to have a polishing pad constructed from both hydrophilic and hydrophobic materials prior to applicant's invention. Additionally, the construction of polishing pads from copolymers is also prior art to the applicant's invention and is in fact notorious. Finally the applicant does not, and can not claim to be the inventor of hydrophilic or hydrophobic repeat units, so these materials are also indisputably within the prior art. Given the knowledge within the prior art as noted above, why would it not have been obvious to construct a polishing pad from a copolymer comprising at least one hydrophilic and hydrophobic repeat unit?

As to the second ground of rejection the applicant appears to base the traversal on the contention that the phrase polishing pad substrate as used in the claim encompasses a pad that can not be read on the pad noted in the rejection. According to applicant "polishing pad substrate" is a well established term in the art. On the other hand, the question is not whether the term is well established or not, but rather what it encompasses. The applicant's position is unconvincing in light of the fact that no definition is given in the subject application for all of the structures which the applicant believes to be encompassed by the phrase "polishing pad substrate". So how can the applicant now argue that this pad or that pad is outside the scope of a claim that merely recites "a polishing pad substrate"? Moreover, it would appear that a substrate of the kind noted in the rejection is inherently capable of use to polish something. More specifically it is noted that the broad claims submitted for examination do not even recite what the claimed pad is to polish. (Coincidentally the examiner does not intend this as a suggestion for

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an amendment that would be considered to render claim 1 allowable). Referring back to independent claim 1, all that the claim is interpreted as reciting, per the usual practice, is a substrate that is *capable* of use for polishing and that comprises the noted materials. This specific combination does not in the examiner's view avoid the prior art.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Geyer appears to disclose a polishing pad comprising a copolymer having at least a hydrophilic and a hydrophobic repeat unit.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob K. Ackun Jr. whose telephone number is (571)272-4418. The examiner can normally be reached on Monday through Friday 8.30AM-5.00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571)272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jacob K. Ackun Jr.
Primary Examiner
Art Unit 3723

J.A.